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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,914	05/02/2001	Y. Tom Tang	PF-0621 USN	5287
27904	7590	03/08/2004	EXAMINER	
INCYTE CORPORATION 3160 PORTER DRIVE PALO ALTO, CA 94304			FRONDA, CHRISTIAN L	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/830,914

Applicant(s)

TANG ET AL.

Examiner

Christian L Fronda

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 05 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 23-31.

Claim(s) rejected: 23-31.

Claim(s) withdrawn from consideration: 21,22 and 32-40.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
NASHAAT T. NASHED PH.D.  
PRIMARY EXAMINER

Continuation of 2. NOTE: Applicants' amendment overcomes the claim objections by rewriting the claims in independent form. However, claims 23-31 as amended would be rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility. Applicants' have provided no arguments other than stating that the rejection is traversed for reasons stated in the response filed 7/24/03. Accordingly, in response to the arguments filed 7/27/03 the claims would be rejected under 35 U.S.C. 101 for the reasons stated in the Final Office Action dated 10/2/2003. Furthermore, claims 23-31 as amended would be rejected under 35 U.S.C. 112, first paragraph, since the claimed invention is not supported by either a credible asserted utility or a well established utility, one skilled in the art clearly would not know how to use the claimed invention.

Claims 23, 26, 27, 28, and 30 as amended would be rejected under 35 U.S.C. 112, first paragraph, since claims 23, 26, 27, 28, and 30 do not meet the enablement requirement. Applicants' arguments filed 12/04/2003 have been fully considered but they are not persuasive. Applicant's position is that the claim 23 as amended would not require screening of all variant sequences that have 70% or 90% identity to SEQ ID NO: 1 since all that is claimed are variant sequences found in nature which could be found by screening cDNA library using hybridization or PCR techniques. The Examiner disagrees for reasons of record as supplemented below.

Guidance for screening and searching for the claimed invention is not guidance for making the claimed invention. In order to make the claimed invention one of ordinary skill in the art must perform an enormous and undue amount of experimentation which encompasses screening and searching libraries and then verifying whether the polynucleotide encodes the claimed "new human myosin heavy chain homolog (MHCH)" by activity assays or selecting specific nucleotides to change (deletion, insertion, substitution, or combinations thereof) in a polynucleotide to make the claimed polynucleotide and determining by assays whether the polypeptide has activity. Such searching and screening is outside the scope of routine experimentation. Furthermore, while the specification shows similarities between regions of SEQ ID NO: 1 and the sequences of accession g127977 and g2444174, similarity is not a disclosure that the claimed invention automatically has the biological function and activity of any myosin heavy chain.

Claims 23, 26, 27, 28, and 30 as amended would be rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' have provided no arguments other than stating that the rejection is traversed for reasons stated in the response filed 7/24/03. Accordingly, in response to the arguments filed 7/27/03 the claims would be rejected for the reasons stated in the Final Office Action dated 10/2/2003.